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PATENT**REMARKS**Restriction Requirement

In response to the restriction requirement under 35 U.S.C. §121, Applicants hereby elect to prosecute the claims of Group II, claims 79-81, directed to the preparation of an N-substituted monoethanolamine.

Amendments

A new paragraph providing a cross reference to related applications has been added to the specification and claims 64-70, 72-77 and 80 have been cancelled. Claims 64-70 and 72-77 correspond to issued claims 64-76 in the parent application, serial number 09/263,171, now U.S. Patent No. 6,232,494.

Applicants have also amended claim 79 to further clarify their invention. In particular, the claim has been amended to replace the term "combining" with "contacting." Support for the claim as amended can be found in the specification generally, for example, at page 55, line 15 to page 57, line 6 and in Example 28 at page 105, line 30 to page 107, line 20. Claim 79 has been further amended to replace the expression "metal-containing catalyst" with the phrase "catalyst comprising a metal selected from the group consisting of platinum and palladium." The new phrase is supported in the specification, for example, at page 56, line 25 to page 57, line 6 and original claim 80 as filed.

Claim 80 has been cancelled in view of the amendments to claim 79.

Upon entry of this amendment, claims 79 and 81 are pending in the application. A version with markings to show the changes made by the foregoing amendments is attached hereto.

Rejection under 35 U.S.C. §112, second paragraph

Claims 64-70, 72-77 and 79-101 stand rejected under 35 U.S.C. §112, second paragraph for failing to properly define the

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invention. Applicants have canceled claims 64-70, 72-77 and 80 and claims 82-101 are subject to restriction. Thus, the following comments are directed to pending claims 79 and 81. For the reasons stated below, reconsideration is respectfully requested of the rejection of claims 79 and 81 under 35 U.S.C. §112, second paragraph.

Claim 79 is rejected on the basis that the expressions "combining", "any non-reactive solvent", and "a metal-containing catalyst" render the claims indefinite by placing no definite limits or boundaries on the claims. Applicants respectfully disagree. "Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." MPEP 2173.02. Thus, it is respectfully submitted that one of ordinary skill in the art reading the specification and the prior art would be fully apprised of the scope of the claims as pending and the claims satisfy the requirements of 35 U.S.C. §112, second paragraph. See MPEP 2173.02; Solomon v. Kimberly-Clark Corp., 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

With regard to the expressions "combining" and "metal-containing catalyst," Applicants have amended claim 79 to replace the expressions with "contacting" and "catalyst comprising a metal selected from the group consisting of platinum and palladium" respectively. Thus, the rejection as to the expressions "combining" and "metal-containing catalyst" has been obviated.

Regarding the expression "any non-reactive solvent," it is respectfully submitted that one skilled in the art would fully understand the meaning of the expression by reading the specification and the prior art. For example, as described at page 56, lines 19-25 of the specification, prior art processes

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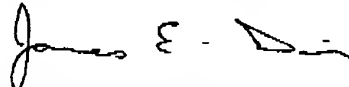
for reductive alkylation of monoethanolamines typically require ethanol, which is not reactive in the reaction mixture, as a solvent to increase selectivity. However, as shown in Example 28 and described at page 56, line 25 to page 57, line 6 of the specification, Applicants have found that the reaction may be conducted essentially in the absence of ethanol or any other solvent which is not reactive in the reaction mixture. Thus, it is respectfully submitted that the expression "non-reactive solvent" is adequately described in the specification and the prior art such that one skilled in the art could understand the meaning of the expression as it is used in claims 79-81.

Because Applicants have amended claim 79 to remove the expressions "combining" and "metal-containing catalyst" and the expression "non-reactive solvent" is adequately defined by the specification and the prior art, it is respectfully submitted that one skilled in the art reading claims 79-81 in the context of the specification and the prior art would be fully apprised of the scope of the claims. Therefore, it is respectfully submitted that claims 79 and 81 as amended satisfy the requirements of 35 U.S.C. §112, second paragraph. Withdrawal of the rejection and early allowance is hereby requested.

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Applicants do not believe that any fees are required by the timely submission of this amendment. However, the Office is hereby authorized to charge any underpayment or credit any overpayment of fees at any time during the prosecution of this application to Deposit Account No. 19-1345.

Respectfully submitted,



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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 703-872-9306 on November 19, 2001.


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VERSION WITH MARKINGS TO SHOW CHANGES MADE
IN THE SPECIFICATION

After the title on page 1:

CROSS REFERENCE TO RELATED APPLICATIONS

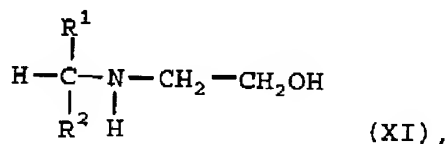
This application is a divisional of application number 09/263,171, filed March 5, 1999 (now U.S. Patent No. 6,232,494), which claims the benefit of U.S. Provisional Application Serial No. 60/096,207, filed August 12, 1998 and which is also a continuation in part of application number 09/023,404, filed February 12, 1998 (now U.S. Patent No. 6,005,140), which claims priority from PCT Application No. US 98/002,883, filed February 12, 1998.

IN THE CLAIMS:

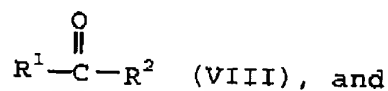
Claims 64-70 and 72-77 have been cancelled.

79. A process for the preparation of an N-substituted monoethanolamine, the process comprising [combining] contacting a ketone, monoethanolamine, and H₂ in the presence of a [metal-containing] catalyst comprising a metal selected from the group consisting of platinum and palladium, and essentially in the absence of any non-reactive solvent,

wherein the N-substituted monoethanolamine has formula (XI):



the ketone has formula (VIII):



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R^1 and R^2 are independently selected from the group consisting of hydrocarbyl and substituted hydrocarbyl.

Claim 80 has been cancelled.